



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/717,502

11/21/2003

Takashi Miyakawa

117848

7620

25944

7590

12/31/2008

OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA, VA 22320-4850

EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

12/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

3  
4  
5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES

8  
9  
10 Ex parte TAKASHI MIYAKAWA and  
11 SATORU INOUE

12  
13  
14 Appeal 2008-4337  
15 Application 10/717,502  
16 Technology Center 1700

17  
18  
19 Oral Hearing Held: Wednesday, November 5, 2008  
20

21  
22  
23 Before BRADLEY R. GARRIS, ROMULO H. DELMENDO, and  
24 JEFFREY T. SMITH, Administrative Patent Judges

25  
26 ON BEHALF OF THE APPELLANT:

27  
28 DANIEL TANNER, ESQ.  
29  
30  
31  
32  
33  
34  
35

1           The above-entitled matter came on for hearing on Wednesday,  
2 November 5, 2008, commencing at approximately 9:55 a.m., at the U.S.  
3 Patent and Trademark Office, 600 Dulany Street, 9th Floor, Alexandria,  
4 Virginia, before Laurie Allen, Notary Public.

5           JUDGE GARRIS: Good morning, Mr. Tanner.

6           MR. TANNER: Good morning, Your Honor. How are you?

7           JUDGE GARRIS: Very well, thank you.

8           Mr. Tanner, as you know, you have about 20 minutes to present  
9 your case. Please begin.

10          MR. TANNER: Well, again, good morning, Your Honor. May  
11 it please the board, I am Dan Tanner, and I'm here to briefly discuss this  
12 morning a process for the production of a honeycomb body. As you  
13 understand from my papers, we believe that there are several errors in the  
14 final rejection, and I'd like to speak briefly to several of those this morning.  
15 Our remarks are going to be primarily directed to the patentability of claim  
16 1, but that's not to imply that we believe that the claims stand and fall  
17 together. There are appropriate arguments made to several of the dependent  
18 claims in our papers that we're going to go ahead and rely on.

19          Claim 1 recites, among other features, adding a predetermined  
20 amount to the raw material for forming -- for forming a honeycomb body, a  
21 powdery material that's made from crushing into maximum particulate  
22 diameter of 50 millimeters a crushed green body. So, this is a reclaimed  
23 material.

24          It's important to note that the crushed body is obtained from a  
25 rejected product of an undried formed material, and therein lies a significant  
26 distinction over what has -- what has been found in the prior art.

1           There have been no problems, or limited problems, in the prior  
2 art of mixing dry and dry materials, and that's going to become important to  
3 the following discussion. However, when you mix undried materials with  
4 these dry materials, you end up creating these fist-like clumps that require  
5 significant further processing.

6           Now, the rejection rejects the pending claims over a  
7 combination of an Asami reference, which is owned by the same patent  
8 owner as the current application, and a Japanese reference which is to  
9 ceramic bodies and wet ceramic materials.

10          The final rejection concedes that the Asami reference doesn't  
11 teach undried reclaimed materials being added to raw ceramic material, but  
12 it goes on to state that at least there is some basis in one embodiment of the  
13 Asami reference that, well, it doesn't necessarily have to be dry, and  
14 therefore, the final rejection uses that presumption or that conclusion as a  
15 stepping off point for then combining with the Japanese reference to go dry  
16 and dry, wet and wet -- and I'm not trying to -- to demean this at all, but it  
17 doesn't -- when it says dry and dry or wet and wet, it doesn't seem to capture  
18 the full intent of the pending claims, and in fact, in the advisory action, the  
19 examiner notes that, as currently presented, the claims do not positively  
20 require that the crushed green body of which we're speaking is necessarily a  
21 crushed undried green body.

22          That position now, interestingly enough, has been reversed in  
23 the examiner's answer, where the examiner now concedes, unfortunately,  
24 almost as an afterthought, that yes, we now recognize -- in fact, on page 17  
25 of the examiner's answer, it says that applicant's argument in this regard is  
26 now persuasive. The examiner agrees that the limitation in the claims is

1 sufficiently clear and that the crushed green body is clearly a crushed  
2 undried green body.

3           The difficulty is that the Asami reference, the principle  
4 reference here, discusses it at 23 different places in the disclosure, and then  
5 specifically recites in the claims combining undried materials, the undried  
6 reclaimed materials with the powdery green materials in order to find the  
7 combinations that they set forth.

8           It talks about dried, unfired scrap in, like I said, 23 different  
9 places, and it also -- it also claims that.

10           Now, in one embodiment that's discussed at column 8, there is a  
11 discussion whereby, in an effort to reduce mechanical impacts as you're  
12 coming up with that material, that reclaimed material, you may choose to  
13 wet it into a slurry like composition and then to strain it, and then you get  
14 this strained material.

15           The examination process, to this point, had told us that, well,  
16 that says that it can be wet. That, unfortunately, ignores a couple of  
17 fundamental positions taken, in our opinion, by the Asami reference, and  
18 that is, first, it talks about dry, unfired scrap throughout.

19           This specific embodiment, then, is only discussed in one of the  
20 ensuing eight examples, where that recovered slurry is then 100-percent  
21 turned into the new process, turned into the new basis. It's not re-mixed, for  
22 instance, with any dried material that may come up with these -- this clay  
23 clumps.

24           All of the mixing that is talked about in the ensuing examples in  
25 the Asami reference have to do with mixing this dried material of example 1  
26 with other combinations of fresh green material.

1                   So, the conclusion that the -- that has been made throughout  
2 prosecution that, well, even though Asami is directed to dry on dry, it could  
3 be expanded to be re-mixing undried back with dried.

4                   We've tried to argue prior, and I'm trying to -- and I am arguing  
5 today, that the difficulty with that conclusion is that it overlooks the problem  
6 that has been found in the prior art, and that is, when you mix this undried  
7 material with the dried material, then it forms these fist-like clumps, and one  
8 of ordinary skill in the art, therefore, would not have been -- it would not  
9 have been predictable to combine the Asami disclosure of dry and dry with  
10 the Japanese reference, which we're just given a very partial English  
11 language translation of a method for molding a wet pottery raw material  
12 with -- pottery raw material having a moderate amount of water is extrusion  
13 formed, and then skipping down to "wherein a part of the ceramic material  
14 extruded by the kneading machine or the vacuum extruding process is  
15 returned back."

16                  So, what the Japanese reference teaches us is mix wet with wet.  
17 What Asami teaches us is mix dry with dry.

18                  What my client has found is that any attempt to mix undried, as  
19 is discussed in paragraph 6 of our disclosure -- to mix undried material with  
20 powdery green material, you end up with these fist-like clumps.

21                  It's the eradication of those, it's the fixing of that problem that  
22 the specific features recited in our pending claims, including the necessary  
23 combination of the slow and fast auger-type, hoe-like mixer/kneader  
24 and -- and the blade-like breaker are all necessary elements to that.

25                  Again, interestingly, throughout prosecution, the examiner has  
26 asserted that he takes official notice of the fact that there are kneaders and

1 breakers and so on out there in the industry that could be used to render  
2 obvious the subject matter of the pending claims.

3           Only in the examiner's answer now is it specifically highlighted  
4 that, okay, Brown, the Brown reference, is a specific example of one of these  
5 that could be used, and yet, we sort of -- again, there hasn't been shown any  
6 reasonable predictability to necessarily making that combination except as  
7 you just sort of try to piece these together without (a) overlooking the  
8 positive disclosures of Asami, (b) stretching the single embodiment of  
9 Asami a little bit farther than it probably should be, and then combining it  
10 with a wet-to-wet ceramic type molding process that's in the Japanese  
11 reference, and then adding on the Brown reference sort of -- sort of for good  
12 measure.

13           We are directed to a very specific problem. Our claims are very  
14 specific in their recitation of what are the necessary minimal elements in  
15 order to meet the claimed process, and we just don't believe that the  
16 obviousness of these claims have been shown over this combination of  
17 applied references.

18           Subject to any questions, that's my presentation, Your Honor.

19           JUDGE DELMENDO: So, the single -- do you deny that they  
20 teach mixing it with fresh raw material?

21           MR. TANNER: Deny?

22           JUDGE DELMENDO: Yes.

23           MR. TANNER: There's no positive recitation --

24           JUDGE DELMENDO: Well, what they're teaching here about  
25 the -- cordierite -- and then, in the next paragraph, it says that the process

1 reclaims cordierite composition if used alone as a starting material for  
2 producing a cordierite ceramic body.

3           Alternatively, the reclaimed cordierite composition is mixed  
4 with a fresh -- of cordierite composition.

5           MR. TANNER: There's no suggestion, Your Honor, that it  
6 remains wet when it's mixed. I think that that's a leap that can't be made  
7 here, and the basis upon which the rejection was formulated was that -- that  
8 it -- that the positive disclosures of these references removes a process step,  
9 and that is the necessity of drying. I think that that stretches even this  
10 disclosure from the Asami reference farther than you really can. I don't  
11 think it's reasonable to conclude, with all of the assertions regarding the  
12 mixture of dry material, that you necessarily get to a conclusion, or even  
13 impliedly get to a conclusion, where this sifted portion is not subsequently  
14 dried or not necessarily subsequently dried.

15           JUDGE GARRIS: Any other questions?

16           JUDGE DELMENDO: No.

17           JUDGE GARRIS: Judge Smith?

18           JUDGE SMITH: No.

19           JUDGE GARRIS: Mr. Tanner, no further questions.

20           MR. TANNER: Thank you, Your Honor.

21           JUDGE GARRIS: Thank you very much.

22           MR. TANNER: Thank you for your time today.

23           Whereupon, at approximately 10:10 a.m., the proceedings were  
24 concluded.